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EXAMINER

KARIM L PEGEMAN

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

07/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,676

Applicant(s)

SKAUG, TERJE

Examiner

PEGEMAN KARIMI

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 12 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment files on 03/12/2008 has been entered and considered by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowers (U.S. Patent No. 6,392,634).

As to claim 1, Bowers discloses a device (10) for giving an already existing electronic device (laptop) an auxiliary function as a pointing device (30), wherein at least one or more pointing components are integrated in the electronic device (52a), thus enabling the electronic device to act together with an external electronic screen device (24), which makes use of the pointing device (col. 4, lines 35-38).

As to claim 2, Bowers teaches the electronic device's (10) already existing optical or radio transmission means (30), (col. 6, lines 62-64) are utilized for wireless connection (90) to the electronic screen device (col. 7, lines 36-38).

As to claim 3, Bowers teaches the pointing device (30) components comprise at least one of the following components: a mechanical or optical reader (70 and 76, see Fig. 5), a button element (50) and a scroll wheel (52a).

As to claims 4 and 7, Bowers teaches the pointing device components (52a) are integrated in an auxiliary unit (30), which is releasably mounted to the electronic device (col. 4, lines 11-13) in such a manner that the auxiliary unit can be released and act as a pointing device separately therefrom (Fig. 6, device 30 is released from recess 58 and is used separately).

As to claims 5 and 8, Bowers teaches the auxiliary unit (30) comprises optical or radio transmission means (90, col. 6, lines 62-64) that permit wireless connection to an electronic screen connection (col. 7, lines 36-38).

As to claims 6 and 9, Bowers teaches the auxiliary unit is a battery pack (Unit 30 can be used wirelessly, which means in order for the device to work there must be a battery pack inside the device).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers and in view of Miyashita (U.S. Patent No. 6,909,906).

As to claim 10, bowers does not teach the electronic device is a mobile phone. Miyashita teaches the electronic device is one of the following devices: a mobile telephone, a personal data assistant (PDA), a digital audio player and a minidisk player (the electronic device that is used as a pointing device is a mobile phone, Figs. 7 and 8). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the mobile phone and pointing device capability of Miyashita's device to the mouse pointing device of Bowers for allowing improved operability of data entry without noticeable volume changes of a portable device itself and further allowing easy entry of a positional coordinate (abstract, lines 1-3).

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. A new ground of rejection is made in view of Miyashita (U.S. Patent No. 6,909,906).

In view of amendment, the reference of Miyashita has been added for new ground of rejections.

Applicant argues that the removable unit is neither an auxiliary function nor an auxiliary function of an existing electronic device. The laptop has a trackball attached to the main body wherein a user can change a position of a cursor by rotating the track

ball. The trackball can be removed from the laptop and used wirelessly as a mouse. The laptop can be used two different ways, one is having the trackball attached and one is having a wireless mouse for cursor movement.

Applicant argues that Bowers merely discloses the mouse unit, that is a detachable part of the laptop, controls cursor movement on the screen of the laptop. It is clearly stated in col. 3, lines 40-44 that a cursor can be moved to any selected position on the screen using either the trackball or mouse pointing device.

Applicant argues that Bowers' removable trackball/mouse unit does not have a main function and an auxiliary function because the trackball/mouse unit only has a main function that is a pointing device. Unit 30 of Bowers is used as a pointing device and the unit is operated having two different functionalities one is used as a trackball attached to the housing of the laptop and the auxiliary functionality is a mouse detached from the housing of the laptop.

The applicant argues that a skilled person would not arrive at solution disclosed in claim 1 in view of Bowers and Miyashita. The mobile phone of Miyashita has a detachable section, which can be used as a pointing device. By combining the two references one person skilled in the art can use the mobile phone of Miyashita to the pointing device of Bowers so that the detachable section of the mobile phone can move the cursor position to any selected position on the screen of Bowers Laptop. The detachable section of the mobile phone can be used as a wireless pointing device.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **PEGEMAN KARIMI** whose telephone number is (571)270-1712 and direct fax number is (571)270-2712. The examiner can normally be reached on Monday-Thursday 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
July 8, 2008

/Chanh Nguyen/
Supervisory Patent Examiner, Art
Unit 2629